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No. 93-862

IN THE
Supreme Court of the United States
OCTOBER TERM, 1993

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Petitioner,
v.
DONNELLEY INFORMATION PUBLISHING, INC., and
THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether the Court of Appeals correctly applied the principles recently stated by this Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), to the particular facts of record before it to hold that the Respondents did not infringe the Petitioner's concededly valid compilation copyright in a telephone directory by (1) copying just the name, address, and telephone number listings appearing in the yellow pages and (2) using the factual information as to kind of business revealed by the descriptive headings under which the listings appeared in Petitioner's directory in order to classify the businesses in Respondents' own, independently chosen, set of categories.

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RESPONDENTS' BRIEF IN OPPOSITION

PRELIMINARY STATEMENT

Respondents Donnelley Information Publishing, Inc., and The Reuben H. Donnelley Corporation (collectively, "Donnelley")[1] respectfully oppose the Petition of BellSouth Advertising & Publishing Corporation ("BAPCO") for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit on the ground that no issue meriting this Court's consideration is presented by the Petition.

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[1] In accordance with this Court's Rule 29.1, Respondents state that named Respondent Donnelley Information Publishing, Inc., was merged into Respondent The Reuben H. Donnelley Corporation on August 31, 1992, with The Reuben H. Donnelley Corporation as the surviving entity. The Reuben H. Donnelley Corporation is a wholly-owned subsidiary of The Dun & Bradstreet Corporation, a publicly traded company.

STATEMENT OF THE CASE

The *en banc* opinion of the Eleventh Circuit below involved a straightforward application of this Court's recent, unanimous decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991) ("*Feist*"), to the question whether Donnelley's extraction of certain factual data from the 1984 Miami yellow pages directory published by BAPCO infringed the compilation copyright claimed by BAPCO in that directory. Contrary to the assertions repeatedly made by BAPCO in its Petition,[2] the case below does not concern the question whether BAPCO's yellow pages directory reflected sufficient original authorship to merit compilation copyright protection for the work as a whole. The validity of BAPCO's compilation copyright in the directory was *stipulated to* by the parties and *assumed* by the Eleventh Circuit. Petitioner's Appendices ("App.") 2a, 4a, 7a & n.11.

The only issue presented, as framed by the Eleventh Circuit at the outset of its opinion, "is whether that which was copied by [Donnelley] was protected by [BAPCO's] registered claim of compilation copyright." *Id.* at 2a. Based on a detailed examination of the summary judgment record below (which, in many respects, was similar to the record in *Feist*), and in accordance with the analysis required by *Feist*, the Eleventh Circuit held that Donnelley had only copied preexisting, public domain facts from BAPCO's directory, and that BAPCO had not shown that Donnelley's copying of these fact data resulted in the copying of any original authorship of BAPCO. *Id.* at 12a, 14a, 18a. Although the fact data copied by Donnelley were "substantial in a purely quantitative sense," the Eleventh Circuit found this "not surprising, given that the copyright protection of a factual compilation is 'thin' " for the reasons explained in *Feist*. *Id.* at 17a (quoting *Feist*, 499 U.S. at 349).

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[2] *See* Petition ("Pet.") 3, 9-11, 14, 16-21.

A. Like The Defendant In *Feist*, Donnelley Had To Extract The Data From The Directory In Order To Attempt To Compete In The Yellow Pages Business.

In 1984, Donnelley began a failed attempt to compete with the local telephone company (Southern Bell Telephone and Telegraph Co. ("Southern Bell")) and its exclusive licensee (BAPCO) in selling and publishing yellow pages directory advertising in Miami and elsewhere in Florida. Like the defendant directory publisher in *Feist*, Donnelley's efforts to compete caused it to become a copyright defendant and an antitrust plaintiff.[3] Donnelley claimed that BAPCO, Southern Bell, and their corporate parent, BellSouth Corporation, had monopolized and attempted to monopolize the market for advertising directories in certain parts of Florida by, *inter alia*, denying Donnelley access to essential telephone subscriber listing information provided by Southern Bell to BAPCO. On summary judgment motions, the district court ruled that Donnelley's antitrust claims against Southern Bell and BellSouth Corporation should go to trial, but the district court also ruled in BAPCO's favor on the copyright claims. The substance of Donnelley's antitrust charges continued against BAPCO in the copyright phase of the case as the foundation of Donnelley's copyright misuse defense.[4]

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[3] *See* William Patry, *Copyright in Collections of Facts (Or Why the White Pages Are Not Copyrightable)*, 12 Comm's & Law 37, 40 (1991) (telephone companies have used claims of copyright not to vindicate intellectual property rights, "but rather to eliminate competition for yellow pages advertisers"); Shira Perlmutter, *The Scope of Copyright in Telephone Directories: Keeping Listing Information in the Public Domain*, 38 J. Copyright Soc'y 1, 1 (Fall 1990) (telephone companies have "sought to eliminate the competition" in the lucrative market for yellow pages advertising by asserting copyright claims).

[4] The district court entered summary judgment in BAPCO's favor on Donnelley's antitrust claims against BAPCO on corporate identity grounds. After the district court's summary judgment rulings, Donnelley dropped its antitrust claims against Southern Bell and BellSouth Corporation in return for BAPCO's abandonment of its demands for monetary relief on its copyright claims.

In the Petition, BAPCO asserts, as if it were a fact, that Donnelley's use of BAPCO's directory was unnecessary in light of a "list" furnished by Southern Bell. Pet. 4. That assertion simply ignores the fact that the district court found Donnelley's antitrust claims against Southern Bell and BellSouth Corporation worthy of trial in part because of a genuine factual dispute as to "[w]hether Southern Bell gave Donnelley sufficient data to realistically compete in the market for directories". App. 100a.

B. Donnelley Used A Particular Method Of Extraction To Obtain From BAPCO's Directory Only Public Domain Facts Needed To Compete In The Yellow Pages Business.

Donnelley obtained copies of BAPCO's 1984 Miami yellow pages directory [5] and extracted certain fact information from it in order to generate a list of potential advertisers. App. 3a. Donnelley marked each business listing in the BAPCO directory with two alphanumeric codes from among a series of codes created by Donnelley. The first code indicated the size (*i.e.*, half page, quarter column) and type (*i.e.*, display ad, in-column, or coloring) of paid advertisement, if any, purchased by the subscriber; the second code indicated the subscriber's type of business by marking the heading selected by the sub-

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[5] BAPCO published the 1984 "Southern Bell Greater Miami Yellow Pages" directory pursuant to an exclusive license agreement with Southern Bell. Southern Bell is a telephone company granted monopoly status to provide telephone service to residential and business subscribers in Miami and other parts of the Southeastern United States. When a business subscribes to telephone service from Southern Bell, Southern Bell obtains the name and address of the business, solicits the heading or classification under which the business wishes to appear in the local yellow pages telephone directory (because one such appearance is included "free" in the price of business-class telephone service), and assigns a telephone number. App. 2a-3a, 14a, 70a n.4. Southern Bell then supplies the subscriber's name, address, telephone number, and business heading selection to BAPCO for publication in the yellow pages directory. Pet. 3; App. 2a-3a, 14a, 70a n.4.

scriber in the BAPCO directory [6] with a code identifying the closest corresponding heading previously and independently selected by Donnelley for use in its competing directory. *Id.* In some cases, the corresponding heading was the same; in other cases, it was different. *Id.* at 12a-13a. Donnelley used its own system of headings and did not copy BAPCO's. *Id.* at 13a.

Donnelley gave the encoded directories to a data entry company, which copied the name, address, and telephone number of each business subscriber appearing in the BAPCO directory. *Id.* at 3a. The data entry company also recorded the alphanumeric codes assigned by Donnelley to each listing, indicating advertising unit and business type. *Id.* By using this particular extraction process, Donnelley copied only preexisting, public domain facts about the business subscribers. Donnelley did not copy any of the headings, advertisements, textual material, typeface, graphic layout, format, or other information appearing in the BAPCO directory. *Id.* at 3a n.2, 12a-13a, 17a.

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[6] As in all yellow pages telephone directories, listings in BAPCO's 1984 Miami directory are assembled alphabetically under standardized business classifications or "headings," which are themselves organized in alphabetical order. App. 3a. The name, address, and telephone number of each subscriber to Southern Bell's business-class telephone service is listed once without separate charge in alphabetical order under the heading the business subscriber selected (a business subscriber may also elect not to appear at all). *Id.* at 3a, 14a. A business subscriber may purchase additional listings under other headings so long as they factually describe the nature of the subscriber's business. *Id.* For example, a barber may choose to be listed under "Barber", "Hair Stylist", or both, so long as the chosen headings are factually descriptive of the barber's business activities. Pet. 4. These headings result from obvious "functional considerations and common industry practice", App. 13a, of describing businesses in plain, ordinary terms that make the directory easy to use. Businesses may also purchase space in the directory for advertisements of various sizes, shapes, and colors; these advertisements typically contain graphic and textual information about individual businesses, such as product lines, hours of operation, and services. *See id.* at 3a n.2.

Donnelley used the data extracted from the BAPCO directory to contact businesses to sell listings and advertisements in Donnelley's yellow pages directory. *Id.* at 3a-4a. The data were also used to develop a listings base for Donnelley's competing publication. *Id.* at 4a.

C. The Decisions Below.

BAPCO's theory of compilation copyright protection at the outset of this case was based on the "sweat of the brow" doctrine, which presumed that the taking of any fruits of a compiler's labor was infringement regardless of whether such labor constituted authorship.[7] Much of BAPCO's evidence thus focused on the *efforts* BAPCO expended in compiling, processing, and publishing yellow pages directories.[8] Seeking to state its "sweat of the brow" premise in the language of the 1976 Copyright Act, BAPCO invoked the words of the Copyright Act's definition of a "compilation," 17 U.S.C. § 101 (1988), to argue that BAPCO's efforts to collect and assemble the directory listings were "acts" of "selection, coordination, and arrangement" sufficient to qualify all of the contents of the directory—including the facts—for compilation copy-

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[7] *See* Amended Complaint ¶ 42 ("BAPCO alleges that Donnelley's preparation of a classified directory using the 1984 Miami Yellow Pages in any shape or form . . . without expending its own 'sweat of the brow' in developing sales leads and potential customer lists is an unlawful use of BAPCO's copyrighted 1984 Miami Yellow Pages."). *See also id.* at ¶ 63. Notably, BAPCO chose to prosecute a "sweat of the brow" case even though BAPCO was litigating in a Circuit that had already rejected the "sweat of the brow" doctrine before the case below was begun. *See Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801, 809 n.9 (11th Cir. 1985) ("*ATD*"), and *Miller v. Universal City Studios*, 650 F.2d 1365, 1369 (5th Cir. 1981) (binding precedent in the Eleventh Circuit under *Bonner v. City of Prichard*, 661 F.2d 1206 (11th Cir. 1981). Since Donnelley copied only facts, BAPCO's claim of copyright protection for facts may have left BAPCO with no choice but to rely upon a "sweat of the brow" theory. *Feist* required the Eleventh Circuit to reject BAPCO's claims.

[8] *See* App. 79a-80a & n.18.

right protection under section 101.[9] BAPCO then argued that *any* substantial copying of fact data appearing in the directory constituted infringement.[10]

1. *District Court Decision.*

The United States District Court for the Southern District of Florida granted BAPCO's motion for summary judgment on the copyright claims and denied Donnelley's cross-motion on those claims. The district court held that "BAPCO and its affiliates have expended great efforts in collecting, assembling, compiling and publishing its directories. . . . There is no doubt, therefore, that BAPCO has met the 'sweat of the brow' test." App. 79a n.18. The district court also held that BAPCO's "acts" of collection, assemblage, and compilation were sufficient to warrant copyright protection for the directories as a whole under section 101. *Id.* at 79a. Although professing to disfavor the "sweat of the brow" theory, *id.*, the district court relied heavily on the Kansas district court opinion ultimately reversed by this Court in *Feist*,[11] and extended copyright protection to naked facts.

2. *The Panel Decision.*

While the case was pending on appeal to the Eleventh Circuit, this Court rejected the "sweat of the brow" doctrine in *Feist*. 499 U.S. at 353-55. In so doing, this Court made clear that "copyright is not a tool by which a compilation author may keep others from using the facts or data he or she has collected. . . . Rather, the facts contained in existing works may be freely copied because copyright protects only the elements that owe their origin to the compiler—the selection, coordination, and arrangement of facts." *Id.* at 359. The issue of infringe-

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[9] *See* App. 80a; Brief of Appellee at 3.

[10] Brief of Appellee at 17-26.

[11] The district court cited to *Rural Telephone Service Co., Inc. v. Feist Publications, Inc.*, 663 F. Supp. 214 (D. Kan. 1987), the lower court decision reversed in *Feist*, no fewer than five times in its opinion below.

ment in any compilation case thus turns on whether what was copied by an alleged infringer owes its origin to the compiler; if the elements copied are preexisting facts or data unoriginal to the compiler, they may be freely copied even if the compiler was the first to discover and record those facts or data.

Notwithstanding the *Feist* decision, a panel of the Eleventh Circuit affirmed the district court's grant of summary judgment based on a *gestalt* theory of compilation copyright that ignored the element-by-element analysis of the copied material required by *Feist*, and instead focused solely on whether BAPCO's directory as a whole was copyrightable. Having determined that BAPCO's so-called "acts" of selection, coordination, and arrangement in collecting and assembling its yellow pages listings were sufficiently original to warrant copyright protection for the work as a whole—a point not even at issue in the case, given Donnelley's *ab initio* stipulation that BAPCO's directory was a copyrightable compilation —the panel wrongly concluded that BAPCO's "acts" became inherent in the preexisting name, address, telephone number, and line of business data contained in the directory. App. 58a-59a. Based on this faulty analysis, the panel held that Donnelley had copied "BAPCO's protected material by substantially appropriating the constituent elements of the original format inscribed in the BAPCO directory." *Id.* at 62a.

3. *The* En Banc *Decision.*

The Eleventh Circuit granted *en banc* rehearing. After correctly applying the element-by-element infringement analysis required by *Feist*, the Eleventh Circuit concluded that Donnelley's particular method of extracting only preexisting name, address, telephone number, and business type fact information from BAPCO's directory did not copy any selection, coordination, or arrangement of the data original to BAPCO. The Eleventh Circuit thus found no copyright infringement. App. 18a.

While expressly assuming the validity of BAPCO's claim of compilation copyright in the directory as a whole, *see id.* at 2a, 4a, 7a & n.11, the Eleventh Circuit held that BAPCO's "acts" of collecting and assembling the listings in its yellow pages directory "were not acts of authorship, but techniques for the discovery of facts." *Id.* at 8a. The Eleventh Circuit further held that:

> The protection of copyright must inhere in a creatively original *selection* of facts to be reported and not in the creative means used to discover those facts. Ultimately, the district court erred by extending the protection of copyright to the collection of facts in the BAPCO directory based on the uncopyrightable formative acts used to generate those listings.

Id. at 9a (emphasis in original) (citations omitted).

The Eleventh Circuit reversed the district court's grant of summary judgment on BAPCO's claim of copyright infringement, and entered summary judgment in favor of Donnelley on that claim. *Id.* at 18a.

REASONS FOR DENYING THE WRIT

The decision of the Eleventh Circuit does not concern copyrightability of classified directories as such, but rather the particular method adopted by Donnelley to extract factual information from a yellow pages directory without copying anything other than facts. BAPCO argued that Donnelley's extraction process necessarily appropriated creatively original elements of BAPCO's directory and that Donnelley therefore failed in its effort to avoid copyright infringement. The Eleventh Circuit rejected BAPCO's argument, concluding that, although the copyrightability of BAPCO's classified directories was not in dispute, Donnelley succeeded in avoiding infringement of BAPCO's copyright.

This Court should not grant *certiorari* because the decision of the Eleventh Circuit is both (i) correct in light of this Court's decision in *Feist*, and (ii) entirely fact-bound by the particular limitations that Donnelley imposed upon its own information extraction process. The

decision below announces no broad principle of law, but rather applies principles recently established by this Court to a particular factual circumstance. BAPCO's attempt to recast this case as one that imperils the future copyrightability of compilations is, in substance, nothing more than a transparent pretext for rearguing the fundamental issues of the *nature* and *scope* of copyright protection for fact compilations already decided by this Court in *Feist*.

I. THE DECISION BELOW IS NOT A SWEEPING RULING ON THE COPYRIGHTABILITY OF CLASSIFIED DIRECTORIES, BUT IS FACT-BOUND BY THE LIMITATIONS SELF-IMPOSED BY DONNELLEY ON ITS EXTRACTION OF FACTS FROM BAPCO'S DIRECTORIES.

Since the copyrightability of BAPCO's directory was stipulated to by Donnelley and assumed by the Eleventh Circuit, infringement would have been found by stipulation if Donnelley had copied any original authorship from BAPCO's directory. Donnelley, however, used a technique designed to permit it to extract just the factual information from BAPCO's directory without infringing the copyright. The Eleventh Circuit decision below rests on a correct finding that what Donnelley copied was only names, addresses, telephone numbers, and the fact as to the nature of the listed business.

As to names, addresses, and telephone numbers, *Feist* is plainly controlling. The taking of such purely factual data is lawful under that decision.

The only possible distinction between the case below and *Feist* thus focuses on what Donnelley did with the descriptive business classifications ("headings") in the yellow pages of BAPCO's book. Donnelley did not copy BAPCO's headings, but instead used the factual information as to kind of business revealed by BAPCO's descriptive headings to classify the businesses appearing under those headings according to Donnelley's own, independently chosen, set of categories.

The inquiry into what Donnelley did with BAPCO's headings was made difficult for the Eleventh Circuit by BAPCO's effort on appeal to create the appearance of a factual dispute when the record was clear that Donnelley did not copy BAPCO's headings. *See En Banc* Brief of Appellees at 27.[12] Rather than simply dismissing BAPCO's accusations of copying the headings as untimely, the Eleventh Circuit conscientiously searched the record and determined that Donnelley's particular method of extracting type-of-business information did not involve copying of BAPCO's system of headings. As explained by the Eleventh Circuit:

> The evidence submitted to the district court in the form of affidavit, deposition, and witness testimony reveals that Donnelley established its own system of headings and that, in constructing its data base, Donnelley entered, with each BAPCO listing, an alpha-numeric code that corresponded to the *Donnelley* heading.

App. 12a-13a (emphasis in original) (numerous record citations omitted).

The Eleventh Circuit further compared the headings appearing both in the sales solicitation forms generated by Donnelley using the data extracted from BAPCO's directory, as well as the headings appearing on pages selected by BAPCO from both the BAPCO directory and Donnelley's competing yellow pages directory. This analysis again disproved BAPCO's claim that Donnelley had copied the system of headings appearing in the BAPCO directory.

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[12] As discussed above, BAPCO relied at the outset of the case on the "sweat of the brow" doctrine in prosecuting its infringement claims. Under that now-discredited theory, Donnelley's copying of name, address, and telephone number listing data alone would have been sufficient to prove copyright infringement. After *Feist*, BAPCO introduced the heading issue on appeal in an unfounded attempt to create a triable issue.

> Considering the extent to which the heading structure of a classified business directory is dictated by functional considerations and common industry practice, the differences apparent in the glossary of headings employed by Donnelley are sufficient to rebut any inference of copying that otherwise might be drawn from those terms that are common to both directories.

Id. at 13a. The Eleventh Circuit thus held that, by employing its particular encoding process, Donnelley had "extracted uncopyrightable information regarding the business activities of BAPCO's subscribers without appropriating any arguably original, protectable expressive element in the BAPCO glossary of headings." *Id.*

The straightforward application of *Feist* principles to the peculiar facts of this case would not present an occasion for *certiorari* even if the Eleventh Circuit had misdetermined the facts or had erred in applying the principles of *Feist*. *Certiorari* is even less appropriate because the Eleventh Circuit was correct both as to the facts and the principles it applied to them.

II. THE DECISION BELOW CORRECTLY APPLIES *FEIST*.

In order to establish a claim of copyright infringement in its directory, "BAPCO must prove '(1) ownership of a valid copyright and (2) copying of constituent elements of the work that are original.'" App. 7a (quoting *Feist*, 499 U.S. at 361). BAPCO claims in the Petition that the Eleventh Circuit "denied copyright protection for BAPCO's directory . . . ." Pet. 16. That assertion, as previously shown, is false. As in *Feist*, the validity of the compilation copyright in the directory as a whole was conceded by the parties below, and the Eleventh Circuit stated no fewer than four times in its opinion that it was not considering "whether BAPCO's yellow pages directory, taken as a whole, is copyrightable." App. 7a n.11; *see also id.* at 2a, 4a, 7a. This case thus presents no issue about the copyrightability of yellow pages direc-

tories or any other type of fact compilation. The Eleventh Circuit considered only one issue below, and that was whether "Donnelley, by taking the material it copied from the BAPCO directory, appropriated BAPCO's *original* selection, coordination or arrangement." *Id.* at 7a (emphasis in original). On that issue, the Eleventh Circuit faithfully followed the principles announced in *Feist* in a manner consistent with the seven other Circuits (including the Second Circuit) that have interpreted *Feist* in the context of fact compilations.[13]

A. BAPCO's "Acts" Of Selection And Coordination Lack Sufficient Originality For The Same Reasons Similar Acts Were Found Insufficient In *Feist*.

BAPCO's *gestalt* theory of copyright posits that the formative acts which caused the preexisting fact information to appear in the directory—as opposed to some other preexisting fact information—make the fact information in the directory copyrightable. Such a principle cannot be squared with *Feist*. In *Feist*, there were a number of actions that caused the Rural Telephone Service Co. ("Rural Telephone") white pages to be what they were rather than something else, such as the particular "close date" selected for the book and the inclusion of all of Rural Telephone's subscribers in one book rather than several (geographic scope). The argument that such content-defining acts were bases for copyright protection was made and rejected in *Feist*. The contentions of BAPCO, here and in the courts below, are simply more prolix statements of the same arguments.

As in its Petition here, BAPCO argued below that its "acts" of "selection" and "coordination" in collecting and assembling the yellow pages listings appearing in its directory were original authorship and so inhered in the facts themselves that no substantial copying of the facts could be permitted. The purported "acts" of "selection," which BAPCO now characterizes as "editorial judgments," in-

[13] *See, infra,* at Part III (pp. 19-29).

clude (1) limiting the yellow pages business directory to business, as opposed to residential, subscribers; (2) providing one "free" listing for each business subscriber (rather than none or more than one); (3) determining the geographic scope of the directory; (4) determining which potential advertisers residing outside of the geographic scope of the directory should be contacted by BAPCO's sales personnel for possible inclusion in the directory; and (5) determining the "headings" that will be available for business subscribers to select from in choosing where to appear alphabetically in the directory. Pet. 3-5. The purported "acts" of "coordination" by BAPCO include (1) coordinating particular business listings with an appropriate heading or headings; and (2) adhering to rules that maintain the "integrity of the directory" by prohibiting business subscribers from appearing under a heading which misrepresents the nature of the subscribers' products or services. *Id.* at 6-7.

The Eleventh Circuit considered each of these "acts" in determining whether Donnelley had appropriated any material original to BAPCO in the course of extracting names, addresses, telephone numbers, and line of business information from the BAPCO directory. In so doing, the Eleventh Circuit correctly concluded that many of BAPCO's "acts" in collecting and assembling these preexisting facts were of the kind previously considered and determined by this Court in *Feist* to lack sufficient originality to extend copyright protection to a directory compiler's selection of the facts (as opposed to the directory as a whole). With respect to the other "acts" alleged by BAPCO, the Eleventh Circuit held that Donnelley had not copied any constituent elements resulting from such acts, and that, in all events, the record in the case below failed to establish any genuine dispute that such constituent elements were unoriginal to BAPCO and therefore uncopyrightable.

The Eleventh Circuit held that BAPCO's purported "acts" of selection lacked sufficient originality to extend copyright protection to the fact data extracted by Don-

nelley. In reaching this holding, the Eleventh Circuit repeatedly referred to this Court's analysis of similar "acts of selection" by the directory compiler in *Feist*. With respect to the geographic scope of BAPCO's directory, for example, the Eleventh Circuit noted that the directory compiler in *Feist* "obviously established a geographic scope . . . for its white pages," App. 8a, and that extending the scope of copyright protection on the basis of this selective act "would protect such factual elements of every compilation; [since] any collection of facts . . . will by necessity have . . . where applicable, a geographic limit selected by the compiler." *Id.*

With respect to other allegedly "selective" acts of BAPCO, such as offering one "free" listing, limiting listings to purchasers of business telephone service, and determining the sales procedures used to contact potential advertisers and to recommend the purchase of additional listings, the Eleventh Circuit found that these "acts of selection" did not—and could not—extend the protection of BAPCO's copyright to the facts themselves.

> [T]hese acts are not acts of authorship, but techniques for the discovery of facts. In *Feist*, the Court emphasized the distinction "between creation and discovery: the first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence." By employing its sales strategies, BAPCO discovered that certain subscribers describe their businesses in a particular fashion and were willing to pay for a certain number of listings under certain available business descriptions.

Id. (citation omitted).

While recognizing that BAPCO had devised its own strategies and techniques for discovering and collecting this subscriber listing information, the Eleventh Circuit noted that any useful compilation "will be shaped by a number of decisions regarding the optimal manner in which to collect the pertinent data . . . ." *Id.* at 9a. These decisions, however, do not constitute authorship;

otherwise, "the protection of copyright would extend to census data, cited in *Feist* as a paradigmatic example of a work that lacks the requisite originality." *Id.* (citation omitted).[14]

The Eleventh Circuit also applied the principles of *Feist* in considering whether BAPCO's "feats of coordination and arrangement to generate its yellow pages directory" constituted original authorship which barred Donnelley's taking of preexisting facts. *Id.* Although BAPCO's yellow pages "required somewhat more organization and arrangement than the white pages directory considered in *Feist*", *id.* at 9a n.13, the Eleventh Circuit held that the organization of listings and headings in BAPCO's directory "did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe the various types of business and then alphabetizes the listings under appropriate headings." *Id.* at 10a n.13. With respect to yellow pages directories, the Eleventh Circuit concluded, "such an arrangement 'is not only unoriginal, it is practically inevitable.'" *Id.* at 10a (quoting *Feist*, 499 U.S. at 363).

The Eleventh Circuit rejected BAPCO's argument, embraced by the district court, that copyrightable originality was established by the mere fact that BAPCO could have arranged its headings and the listings appearing under those headings in other ways.

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[14] *See also* Perlmutter, *supra* note 3, at 13-17 (After analyzing purported "acts" of selection, coordination, and arrangement, like those alleged by BAPCO, in the collection and assembling of telephone listings: "If copyright is disclaimed in listing information, disclaimed in the alphabetical arrangement of that information, and it is the subscribers rather than the telephone company who select themselves for inclusion, what authorship has the telephone company contributed? All that remains is the mere pulling together and publishing of all of the unprotectible data in one place in an unprotectible form. It is hard to see any difference between this contribution and plain 'sweat'—the effort expended by the compiler.")

> The relevant inquiry is not whether there is some imaginable, although manifestly less useful, method of arranging business telephone listings. In *Feist*, Rural could have published multiple directories for its service area or listed its numbers in numerical order, by age, or by neighborhood within a single directory. The pertinent inquiry is whether the compiler has demonstrated originality, the "*sine qua non*" of copyright, in *its* arrangement or coordination.

Id. at 12a (emphasis in original). The Eleventh Circuit concluded that BAPCO's arrangement of its yellow pages listings, "like that of Rural's white pages [listings] is 'entirely typical' of its respective type." *Id.*[15]

Having found that BAPCO's acts of selection and coordination in organizing business listings in its directory were unoriginal for reasons explained by this Court in *Feist*, the Eleventh Circuit reached the inevitable conclusion that Donnelley's extraction of names, addresses, and telephone numbers from BAPCO's directory—which are the same factual data extracted by Feist from Rural Telephone's directory—did not constitute infringement.

B. Donnelley Did Not Copy Any Elements Resulting From BAPCO's Other Acts, Which Also Were Not Shown To Manifest Sufficient Originality To Be Copyrightable.

The only remaining issues below were whether Donnelley copied BAPCO's headings and, if so, whether those headings were sufficiently original to BAPCO to merit copyright protection. After a detailed examination

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[15] The Eleventh Circuit also held that BAPCO's claim of copyright protection in the arrangement of listings in its yellow pages directory would not survive application of the "merger" doctrine, because the alphabetical listing of business subscribers under an alphabetical sequence of appropriate headings was "the one way to construct a useful business directory." App. 10a-11a. Thus, "the arrangement has 'merged' with the idea of a business directory, and . . . is uncopyrightable." *Id.*

of the record, the Eleventh Circuit ruled in Donnelley's favor on both counts.[16]

As noted above, the Eleventh Circuit found that there was no genuine dispute as to the fact that Donnelley's particular method of extraction did not result in the copying of BAPCO's headings. App. 13a. Second, even if Donnelley had copied BAPCO's system of headings, the Eleventh Circuit found that BAPCO had "failed to present evidence that . . . its heading structure constitutes original expression warranting copyright protection." *Id.* at 14a. Besides being so obvious as to lack any originality,[17] most of the headings employed by BAPCO were shown below to be the result of standard industry practices common to virtually all yellow pages publishers. *Id.* The Eleventh Circuit further found that the testimony of BAPCO's own representatives established that the *subscribers* selected, from among the headings offered by BAPCO, the particular heading or headings under which they wished to appear. "The headings that actually appear in the directory thus, do not owe their origin to BAPCO and BAPCO has claimed no copyright in the larger universe of headings that are offered to subscribers." *Id.* at 14a-15a.

Finally, the Eleventh Circuit noted that Donnelley did not copy any of the other material in the BAPCO directory, such as the text or graphic elements of advertisements, the layout and formatting of the pages, "or the

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[16] Given the conclusion that Donnelley did not copy BAPCO's headings, the rulings concerning the adequacy of BAPCO's evidence on the originality of those headings is simply an additional, alternative ground of decision for granting Donnelley's summary judgment motion. Either conclusion, standing alone, would establish non-infringement.

[17] In the words of BAPCO's counsel: "Where are you going to put somebody if he is a plumbing contractor? The heading is going to be Plumbing Contractor. It has got to be. The dispute between these two companies does not involve the wording of the heading, your Honor. It has no significance of any real merit." 5SR-Tr. of Oct. 1985 Prel. Inj. Hrg. at 8.

textual material included by BAPCO to assist the user." *Id.* at 17a.

> Unlike the infringer in *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th Cir. 1985), Donnelley did not photocopy, or reproduce by any equivalent means, the page by page arrangement or appearance of its competitor's directory in the process of creating its own work.

Id.[18] While the Eleventh Circuit recognized that the *amount* of material extracted by Donnelley from the BAPCO directory "was substantial in a purely quantitative sense, Donnelley did not, by this process, appropriate whatever original elements might arguably inhere in the BAPCO directory." *Id.*[19]

III. THE DECISION OF THE ELEVENTH CIRCUIT IS CONSISTENT WITH DECISIONS OF OTHER CIRCUITS APPLYING *FEIST*.

BAPCO bases its Petition primarily upon the argument that there is a conflict in the Circuits requiring this Court's attention. The opinion below neither reveals nor acknowledges any such conflict, no other Circuit opinion

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[18] The Eleventh Circuit's affirmation of *ATD* further shows that the Eleventh Circuit recognizes that yellow pages directories, as a whole, may be subject to copyright protection and infringed by takings of protected authorship. Read together, the Eleventh Circuit's decision below and its decision in the *ATD* case underscore the fact-specific inquiry required to determine whether particular copying of information from a directory results in the extraction of only uncopyrightable public domain facts, as in the case below, or in the appropriation of other elements of the work original to the directory publisher, as in *ATD*.

[19] *See* Paul J. Heald, *The Vices of Originality*, 1991 Sup. Ct. Rev. 143, 162 (After observing that copying of listings and headings probably would not infringe: "Contrary to prior lower court precedent, *Feist* clearly sanctions the production of competing yellow pages as long as the second-comer's product does not substantially reproduce the individual page-by-page arrangements of materials found in the first (something only likely to result from photocopying).").

has revealed or acknowledged any such conflict, and there is none.[20]

A. There Is No Conflict Between The Second And Eleventh Circuits.

As shown, BAPCO's infringement theory was and remains that possession of a valid compilation copyright should entitle BAPCO to bar all substantial copying—even of facts—from the compilation. That position leads BAPCO to insist upon addressing only the question of existence of copyright protection for its directory, even though that question was never in issue in the courts below.

Based on this false premise, BAPCO incorrectly asserts that the Eleventh Circuit decision is in conflict with an earlier, post-*Feist*, decision of the Second Circuit: *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991) ("*Key*"). BAPCO asserts that the Eleventh Circuit below construed *Feist* "as precluding copyright protection for a yellow pages directory [while] the Second Circuit in *Key* construed *Feist* as affording such protection." Pet. 11. Neither part of this statement is correct: The Eleventh Circuit assumed at the outset that BAPCO's directory was copyrightable in reliance on Donnelley's stipulation to that effect; the Second Circuit in *Key* did not address whether typical yellow pages directories, such as BAPCO's, might be copyrightable, since no such directory was before it. Rather, the two decisions each applied the same inherently fact-intensive analysis required by *Feist* to dif-

[20] BAPCO's arguments on this point are ironic, since the Eleventh Circuit took particular care to ensure the consistency of its *en banc* decision with the post-*Feist* decisions of other Circuits by specifically directing, in its November 4, 1992 order setting the schedule for the *en banc* rehearing, that the parties address the then-recent decisions in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991); *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991); *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851 (6th Cir. 1991); and *Illinois Bell Tel. Co. v. Haines & Co.*, 932 F.2d 610 (7th Cir. 1991).

ferent factual issues. The treatment and resolution of the one significant issue common to the cases are entirely consistent.

1. *The* Key *Decision.*

Key involved claims that the publisher of a specialized classified directory for the Chinese-American community in New York had infringed the copyright on another specialized directory directed to the same group of Chinese-American users. Unlike the case below, the *Key* case required the Second Circuit to decide, first, whether the plaintiff held a valid copyright. The Second Circuit found the evidence presented by the plaintiff sufficient to establish that the plaintiff's directory embodied a creative selection, from the larger universe of businesses in New York, of just those businesses that the plaintiff subjectively determined to be of interest to the Chinese-American community and that the plaintiff thought would remain open for business during the life of the directory. *Key*, 945 F.2d at 513.[21] The Second Circuit also held that the evidence showing selection and creation of business classifications—including, significantly, classifications "not common to yellow pages"—was sufficient to establish originality in the arrangement of the plaintiff's compilation. *Id.* at 513-14. The Second Circuit found these elements of original selection and arrangement to be sufficient to support a valid compilation copyright on the plaintiff's directory as a whole. *Id.* at 514.

After making this determination, the Second Circuit proceeded to the second analytical step required by *Feist*; namely, whether the alleged infringer had copied constituent elements protected by the copyright. The Second

[21] Although BAPCO contends otherwise, Pet. 13 n.5, it is plain that the selectivity inherent in the specialized nature of the directory in *Key* was central to the originality finding. *See Mid Am. Title Co. v. Kirk*, 991 F.2d 417, 420-21 (7th Cir.), *cert. denied*, 114 S. Ct. 346 (1993) (summarizing *Key* as holding that "copyright protection could be extended to a directory of businesses of specific interest to the Chinese community").

Circuit focused just on those elements proved to be original to the plaintiff and determined that infringement was *not* proved because the defendant's directory did not reproduce either the plaintiff's particular selection of businesses deemed to be of interest to a specialized group or any original aspect of the plaintiff's classification scheme. *Id.* at 515-16. There being no evidence of copying of original constituent elements of the plaintiff's work, there could be no infringement under *Feist*. *Id.* at 516.

2. Key *Is Dissimilar From The Case Below.*

The Eleventh Circuit below was confronted with a very different case from *Key*. There was no issue whether BAPCO's typical yellow pages directory was copyrightable: just like the defendant in *Feist*, Donnelley conceded that the presence of original artwork, layout, and textual material in the yellow pages of BAPCO's directory was sufficient to sustain a valid compilation copyright on the directory as a whole. The sole question before the Eleventh Circuit was whether Donnelley's admitted copying of names, addresses, and telephone numbers, and its use of BAPCO's factually descriptive classification of businesses to identify the kind of business carried on by the listed telephone subscribers, resulted in the copying of original material from BAPCO's directory. App. 2a.

In *Key* there was a factual issue as to whether the defendant had copied the original aspects of the plaintiff's classification scheme. In the case below, the Eleventh Circuit determined that there was no genuine issue as to the fact that Donnelley did not copy BAPCO's headings. *See* pp. 8-9, above.

BAPCO goes so far as to assert that, "[u]nder the Eleventh Circuit's view, the publishers of the yellow pages in *Key Publications* simply 'discovered' those businesses of interest to the Chinese-American community that were willing to be listed." Pet. 13. Of course, the Eleventh Circuit said no such thing. Indeed, the Eleventh Circuit's opinion makes quite clear that it would be likely to find the original selection of listed firms in *Key* to con-

stitute precisely the sort of creative selection absent from the record in the case below. *See* App. 8a-9a, 16a n.22.[22]

3. *On The One Common Issue Below And In* Key, *The Eleventh And Second Circuits Are In Total Agreement.*

The case below and *Key* presented only one significant question in common: whether classification of business listings under descriptive categories—*e.g.*, classifying a plumber as a plumbing contractor—is original authorship protectable by copyright. On this point, the Eleventh Circuit and the *Key* court are in total agreement. The Second Circuit held, as a matter of law, that "[p]lacing listings within categories is the sort of mechanical task that does not merit copyright protection." *Key*, 945 F.2d at 515. The Eleventh Circuit reached the same conclusion, on the record before it, on factual grounds. App. 14a.

4. *Other Second Circuit Cases Further Disprove Any Conflict Between The Two Circuits.*

The absence of any conflict between the Second and Eleventh Circuits in the application of *Feist* is confirmed by examination of other decisions of the Second Circuit applying *Feist*. BAPCO mentions in its Petition only one other post-*Feist* Second Circuit case: *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991), *on remand*, 795

[22] BAPCO contends that a conflict between the Second and Eleventh Circuits is also to be inferred from the Eleventh Circuit dissent's reliance on *Key*. The dissent's extensive reliance on the portion of *Key* concerning copyrightability of the *Key* plaintiff's directory reflects the dissent's acceptance of BAPCO's argument that proof of copyrightability was all that was needed to show infringement. BAPCO fails to acknowledge the Eleventh Circuit majority's citation to *Key* on the crucial question of what must be shown to prove infringement, App. 16a n.22, and does not address the fact that the dissent would have found copyrightable authorship in BAPCO's classification of listings under particular headings, *id.* at 27a, whereas the majority in the Eleventh Circuit and the Second Circuit in *Key* are entirely in agreement in holding to the contrary, as discussed in subpart 3, below.

F. Supp. 1325 (S.D.N.Y. 1992), *aff'd*, 3 F.3d 656 (2d Cir. 1993), *petition for cert. filed* (U.S. Nov. 30, 1993) (No. 93-863) ("*Kregos*"). In *Kregos*, the district court originally entered summary judgment in favor of the defendants on the plaintiff's copyright claims relating to a compilation of baseball statistics known as a "pitching form". *Kregos v. Associated Press*, 731 F. Supp. 113 (S.D.N.Y. 1990). On the first appeal, the Second Circuit reversed the summary judgment and remanded for trial on the fact-intensive issues of originality and infringement. Contrary to BAPCO's assertion, Pet. 24, the Second Circuit did not "uph[o]ld the copyrightability of a pitching form" but rather held only that the record did not warrant summary judgment for the defendants on the issue of originality. The Second Circuit specifically noted that:

> Our ruling that Kregos' copyright claim survives defendants' motion for summary judgment does not, of course, mean that he will necessarily obtain much of a victory. "Even if a work qualifies as a copyrightable compilation, it receives only limited protection . . . . [C]opyright protects only the elements that owe their origin to the compiler—the selection, coordination, and arrangement of facts." *Feist*, —U.S. at —, 111 S.Ct. at 1294. If Kregos prevails at trial on the factual issues of originality and creativity, he will be entitled to protection only against infringement of the protectable features of his form. Only the *selection* of statistics might be entitled to protection. We agree entirely with Judge Goettel that nothing in Kregos' *arrangement* of the selected statistics displays the requisite creativity.

Kregos, 937 F.2d at 709 (emphasis in original). There is certainly no inconsistency between these rulings and those of the Eleventh Circuit.

On remand, the district court again granted summary judgment in favor of the defendants. *Kregos v. Associated Press*, 795 F. Supp. 1325 (S.D.N.Y. 1992), holding, in part, that one of Kregos' pitching forms was copyrightable but could not be infringed as a matter of law by a

pitching form on which four or five out of ten of the categories of statistics differed. The Second Circuit affirmed this ruling. *Kregos v. Associated Press*, 3 F.2d 656 (2d Cir. 1993). Thus, in *Kregos*, as in the case below, close scrutiny of what the defendants were alleged to have copied from the plaintiff's work revealed the absence of any infringement.

Although BAPCO does not mention the fact in its Petition, the Eleventh Circuit cited *Kregos* (App. 10a) and two other post-*Feist* Second Circuit cases: *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991) ("*Lalli*") (App. 10a n.13) and *Arica Institute, Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992) ("*Arica*") (App. 18a n.24), in its *en banc* decision. The issue in *Lalli* was whether, in light of *Feist*, "a compilation of information gleaned from horse racing statistics" was sufficiently original to be copyrightable. *Lalli*, 936 F.2d at 672. The Second Circuit affirmed a pre-*Feist* district court ruling that the plaintiff's charts of numbers for use by gamblers were not sufficiently original to be copyrightable, despite the plaintiff's investment of labor in compiling and calculating the material on the charts. *Id.* at 673-74. In citing *Lalli* on the issue of originality, the Eleventh Circuit expressly applied the same originality standard as was applied by the Second Circuit in *Lalli*.

In *Arica*, as in the case below, copyrightability of the plaintiff's work was not in dispute; the issue was infringement. The Second Circuit closely examined the plaintiff's and defendants' works on psychology to see if copyrightable elements of the plaintiff's work had been taken. As required by *Feist*, the Second Circuit proceeded element-by-element, finding, among other things, that material held out as factual could not be original and therefore copying of it could not be infringement. *Arica*, 970 F.2d at 1075-76. Finding some allegedly copied elements of the plaintiff's works uncopyrightable and the copying of other elements to be fair use, the Second Circuit affirmed a summary judgment in favor of the defendants.

Singly or together, these cases reveal no conflict between the Second and Eleventh Circuits. Like the decision below, *Key*, *Kregos*, *Lalli*, and *Arica* all illustrate efforts to carry out the fact-specific analysis required by *Feist*. BAPCO's contention that the Eleventh and Second Circuits are in conflict over the interpretation of *Feist* is groundless.

B. There Is No Conflict With Other Circuits' Interpretation Of *Feist*.

BAPCO says that "defendants in copyright actions are relying on *Feist* to argue that compilations previously recognized as entitled to copyright protection are no longer protected", Pet. 21-22, and contends that there is a resulting trend toward a "limited reading of *Feist*". *Id.* at 27. As examples for this asserted proposition, BAPCO cites (in addition to the Second Circuit's 1991 decision in *Kregos*) just three of at least twelve Circuit-level compilation copyright decisions applying *Feist*.[23]

BAPCO first discusses, *see id.* at 22-24, the District of Columbia Circuit's decision in *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992) ("*Atari*"), which involved copyrightability of an audiovisual work (defined in the Copyright Act as a work that consists of "a series of related images", 17 U.S.C. § 101 (Supp. IV 1992)), not

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[23] *Kregos v. Associated Press*, 3 F.3d 656 (2d Cir. 1993), *petition for cert. filed* (U.S. Nov. 30, 1993) (No. 93-863); *Mid Am. Title Co. v. Kirk*, 991 F.2d 417 (7th Cir.), *cert. denied*, 114 S. Ct. 346 (1993); *Harper House, Inc. v. Thomas Nelson, Inc.*, 5 F.3d 536 (9th Cir. 1993), *petition for cert. filed* (U.S. Dec. 10, 1993) (No. 93-916); *The Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, No. 92-1256, 1993 U.S. App. LEXIS 27045 (10th Cir. Oct. 19, 1993); *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992); *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410 (7th Cir. 1992); *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992); *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509 (2d Cir. 1991); *Victor Lalli Enters., Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991); *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851 (6th Cir. 1991); *Illinois Bell Tel. Co. v. Haines & Co.*, 932 F.2d 610 (7th Cir. 1991).

alleged infringement of fact compilations. In analyzing the copyrightability of an audiovisual work composed of uncopyrightable images, the court drew an analogy to compilations on the ground that an audiovisual work, like a compilation, may consist of uncopyrightable elements, the selection and arrangement of which may be protectable. Because an audiovisual work is one that, by definition, consists of a flow ("series") of images, the court faulted the Register of Copyrights for basing his decision as to originality on the individual images rather than on whether the "flow" of the images was original. *Atari*, 979 F.2d at 245.

BAPCO seeks to draw from *Atari* the inference that the District of Columbia Circuit construed *Feist* to embrace the *gestalt* theory of compilation copyright on which BAPCO relied in the courts below. *Atari* does not bear that inference because audiovisual works, by definition, owe their copyrightability not to "constituent elements of the work that are original," *Feist*, 499 U.S. at 361 (citation omitted), but to an original flow of the elements, whether or not those elements are original. *Atari* does not say that copying of uncopyrightable elements from a copyrightable audiovisual work would infringe the copyright, nor could it in light of the plain holding of *Feist*. BAPCO's reliance on *Atari* simply evidences again its continuing effort to confuse the separate questions of copyrightability and infringement.

The second case cited by BAPCO is the Ninth Circuit's most recent opinion in *Harper House, Inc. v. Thomas Nelson, Inc.*, 5 F.3d 536 (9th Cir. 1993) (full text reported at Nos. 91-55426, 91-55550, 91-55774, 1993 U.S. App. LEXIS 23390 (9th Cir. Sept. 10, 1993)), *petition for cert. filed* (U.S. Dec. 10, 1993) (No. 93-916) ("*Harper House*"). *Harper House* simply found that a genuine factual dispute as to the originality of the plaintiff's work should have been submitted to a jury. 1993 U.S. App. LEXIS 23390, at *7. Contrary to BAPCO's contention, Pet. 25, the Ninth Circuit did not make *any* ruling as to copyrightability or infringement.

BAPCO's final example of alleged conflict, *Mason v. Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992) ("*Mason*"), involved real estate title maps. *Mason* simply illustrates again how a plaintiff that proves the originality of its selection, coordination, or arrangement of material in a compilation, and further proves that its original authorship has been copied by another, may prevail in a copyright infringement action under the principles established in *Feist*.[24]

BAPCO does not mention several cases that further confirm that the Circuits are having no difficulty applying the teachings of *Feist*. In addition to the District of Columbia, Second, Fifth, and Ninth Circuit cases discussed above, *Feist* has been applied to compilation copyright issues in at least the Sixth, Seventh, and Tenth Circuits. *See The Gates Rubber Co. v. Bando Chem. Indus., Ltd.* No. 92-1256, 1993 U.S. App. LEXIS 27045 (10th Cir. Oct. 19, 1993) (applies *Feist* to require element-by-element analysis of computer program, and finds no infringement as to unoriginal elements); *Mid Am. Title Co. v. Kirk*, 991 F.2d 417 (7th Cir.), *cert. denied*, 114 S. Ct. 346 (1993) (emphasized inherently factual nature of the originality inquiry requirement of *Feist* and reversed a Rule 12(b)(6) dismissal of a copyright infringement claim on the grounds that *Feist* imposed no special pleading requirements); *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 414 (7th Cir. 1992) (no infringement of compilation copyright in office supply catalog: "[G]iven the utilitarian and hence inevitably rather standardized format of a mail order catalog of office supplies", no original authorship shown to have been copied); *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851 (6th Cir. 1991) (applies *Feist* to determine the copyrightability of a claimed compilation of signs; find-

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[24] BAPCO also mentions *Los Angeles News Service v. Tullo*, 973 F.2d 791 (9th Cir. 1992), a case having to do with copyrights on raw videotapes of news events, rather than compilations, with no apparent relevance to the matters at issue here.

ing neither a compilation nor original authorship, affirmed summary judgment for the defendants).

As a whole, the developing case law under *Feist*—while still in its infancy—reveals no confusion or inconsistency in principle or application. The Eleventh Circuit decision below follows the pattern common to all of these cases: it applies the originality requirements of *Feist* to the particular facts before the court.

IV. BAPCO'S REAL DISPUTE IS WITH THIS COURT'S DECISION IN *FEIST*.

BAPCO asserts that the Eleventh Circuit erred by "evaluating creativity on an element-by-element basis rather than judging the compilation as a whole." Pet. 11. In the context of the infringement issues present in the case below, this is simply an attack upon the Eleventh Circuit's refusal to rule that the facts within BAPCO's compilation of facts were protected expression that could not be copied without infringement. The Eleventh Circuit's decision in this regard was mandated by *Feist*, which holds that:

> [f]acts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.

499 U.S. at 350-51. *Feist* further holds that "[n]otwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the *same* selection and arrangement." *Id.* at 349 (emphasis added).

Given these plain holdings of this Court, which were faithfully followed by the Eleventh Circuit below, BAPCO's Petition is revealed to be nothing more than an attack upon this Court's recent, unanimous decision in

Feist.[25] BAPCO's Petition presents no good reason to overrule the *Feist* decision, and there is none.

CONCLUSION

BAPCO's Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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[25] This impression is strengthened by the announced intention of many of the *amici* who appeared in support of Rural Telephone in *Feist* to defend the "sweat of the brow" doctrine (including West Publishing Company and various local telephone companies and their affiliated directory publishers) to seek leave to file *amicus* briefs in this Court in support of BAPCO (whose corporate parent, BellSouth Corporation, also appeared in *Feist* in support of Rural Telephone and made substantially the same arguments now being reargued by BAPCO in its Petition).